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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,617	09/15/2000	Kia Silverbrook	IR25US	3567

24011 7590 09/21/2004

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/662,617

**Applicant(s)**

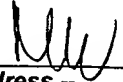
SILVERBROOK, KIA

**Examiner**

James A. Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander et al. in view of Cosgrove et al.

Zander et al. teaches a method of preventing unauthorized recycling of single-use cameras but permitting authorized reuse by first determining that a particular event in the camera has occurred, then disabling a function of the camera to prevent unauthorized reuse of the camera and then inputting a reset code to the camera to re-enable the function that has been disabled to permit authorized reuse of the camera (column 2; lines 34-42).

Examiner notes that Zander et al. teaches a plurality of one-time use(single-use) cameras including authentication means, in this case the authentication means is reset code. In addition the Zander et al. clearly includes a refurbishing station for refurbishing camera by replenishing consumables where the authentication means authenticates whether or not the refurbishing station is authorized to effect refurbishing. In this case the refurbishing station is authenticated if they can provide the correct reset code.

Examiner further notes that the limitations of dependent claims 10 and 11 are also anticipated by Zander et al. Specifically, rendering the camera inoperative and running a test routine after the reset code has been entered to make sure the camera is working properly.

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Zander et al. does not teach a single use digital camera. Cosgrove et al. teaches digital one-time use cameras (column 1; line 40). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the camera of Zander et al. to be a digital one-time use camera as taught by Cosgrove et al. in order to allow users to take digital photos.

Claims 2-8 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander et al. in view of Cosgrove et al. as applied to claims 1 and 9-11 above, and further in view of Admitted Prior Art.

Zander et al. does not teach the retail price, manufacturing cost, refurbishing cost, refund amount or refurbishing cost. The common knowledge or well-known in the art statement made by the Examiner in the Office Action mailed 3/11/04 is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or the traverse was inadequate (MPEP2144.03(C)). Specifically Examiner retail price, manufacturing cost, refurbishing cost, refund amount or refurbishing cost are old and well known. In addition, it is old and well known to manipulate these variables in order to maximize profits. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Zander et al. by manipulating the relationship between retail price, manufacturing cost, refund rate and refurbishing costs in order to maximize profits to the company.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,238,033 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Independent claims 1 and 9 of the instant application, include a plurality of one-time use digital cameras each camera with an authentication means. Patent 6,238,033 merely states that the authentication means is an interrogation means. Examiner asserts that an interrogation means is merely an old and well know authentication means, therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the

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authentication means of instant application by specifically calling it an interrogation means, in order to indicate the specific type of authorization means.

Patent 6,238,033 does not teach the retail price, manufacturing cost, refurbishing cost, refund amount or refurbishing cost. Examiner takes Official Notice that these numbers are old and well known. In addition, it is old and well known to manipulate these variables in order to maximize profits. Examiner asserts that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system claim 1 in patent 6,238,033 by manipulating the relationship between retail price, manufacturing cost, refund rate and refurbishing costs in order to maximize profits to the company

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Response to Arguments***

Applicant's arguments filed 6/11/04 have been fully considered but they are not persuasive. Applicant asserts that Zander fails to teach a camera that authenticates a refurbishing station. Examiner respectfully disagrees. The abstract of Zander states, "A reset code must be inputted to the camera to initialize the exposure counter and to enable the electronic flash capability". Examiner noted in the previous Office Action that Applicant's "authentication means is reset code (of Zander) . . . In this case the refurbishing station is authenticated if they can provide the correct reset code." Examiner stands by this comment. The refurbishing station

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must enter a reset code. The reset code is the means within the camera for the camera to authenticate the refurbishing station.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

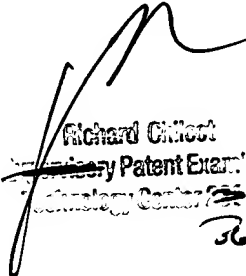
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

  
Richard Chiles  
Primary Patent Exam.  
Electronic Business Center